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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/042,320	01/11/2002	Fumio Sugaya	Q66578	4444

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EXAMINER

CROSS, LATOYA I

ART UNIT PAPER NUMBER

1743

DATE MAILED: 12/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/042,320

Applicant(s)

SUGAYA ET AL.

Examiner

LaToya I. Cross

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

This Office Action is in response to Applicants' amendments filed on September 29, 2004. Claims 1-13 are pending.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 10 – 13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 10 recites that the pressing member is removed from the dry analysis chamber independently from other elements comprising the incubator. The original specification does not provide for such a limitation. The specification merely recites that the pressing member is removable from the dry analysis chamber to facilitate cleaning and/or maintenance. The specification does not mention that the pressing member is removable independent of any other elements.

Claims 11 and 13 recite that the pressing member has a chamfered surface. The specification at page 8 states that the outer edge of the pressing member is tapered. This statement does not provide adequate support for the entire surface of the pressing member

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being chamfered. Applicants' should amend the claims to recite that the pressing member has a tapered outer edge.

Claim 12 requires that the pressing member comprise a planar surface sized to contact a substantial area of the dry analysis element to facilitate transfer of heat. The specification does not provide support for this limitation. At page 8, the specification provides that the pressing member has a flat pressing portion which presses on the dry analysis element to close the spotting hole. The specification also provides that pressing portion may be smaller than the dry analysis element so long as the spotting hole is tightly closed. The specification does not contain support for a planar surface contacting a substantial area of the dry analysis element to facility transferring heat.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 4, 5, and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 5,496,518 to Arai et al.

Arai et al teach an incubator. The incubator comprises a cell/chamber (64) for a dry chemical analysis element (1). The cell/chamber (64) is heated with heaters (48, 57) and maintains a constant temperature within the cell/chamber (64). The incubator further comprises a pressing member (61) disposed within cell/chamber (64). See figure 5. The pressing member (61) presses downward onto analysis element (1) and fixes the analysis

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element (1) in a position within the cell (64), as recited in claim 7. The downward action of the pressing member (61) is caused by a spring (62), as recited in claim 2. See col. 7, lines 7-22.

Within cell/chamber (64), a guide member (64b) is disposed. The guide member (64b) guides the pressing member (61) upward and downward (col. 7, lines 33-36). Heater (57) is provided on the outer surface of cell cover (46). Heater (57) allows cell (64), guide member (64b) and pressing member (61) to be held at a predetermined temperature (col. 11, lines 35-40), as recited in claim 4. Regarding claim 5, Arai et al teach a cell cover (46) having the heater (57), which is in contact with the guide (64). With respect to claim 3, Arai et al teach that the pressing member (61) may be integral with the cell member (64). The reference further teaches that cell member (64) can be easily removed from the incubator for cleaning or replacement (col. 11, lines 59-61; col. 12, lines 14-16). Thus, pressing member (61) is inherently capable of being removed also.

Therefore, for the reasons set forth above, Applicants' claimed invention is deemed to be anticipated, within the meaning of 35 USC 102(b) in view of the teachings of Arai et al.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

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1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
5. Claims 1-3, 6-8 and 10-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arai et al '518 in view of US Patent 4,814,279 to Sugaya.

The disclosure of Arai et al is described above. Arai et al differ from the instantly claimed invention in that there is no disclosure of 1) the pressing member defining a top surface of the chemical analysis chamber, 2) the pressing member having a tapered surface, or 3) the pressing member contacting a substantial area of the analysis element.

Sugaya teaches an incubator (6) comprising a pressing member (20) having a tapered outer edge (19). See col. 4, lines 31-41. The pressing member presses onto slide/analysis element (1) to hold slide (1) in place. The pressing member (20) also contacts a substantial portion of slide (1), forming the top portion of slide chamber. It would have been obvious to one of ordinary skill in the art to modify Arai et al by using a tapered outer edge to allow the slide to move into the incubator more easily. Further, it would have been obvious to provide a flat pressing member that defines a portion of the analysis chamber to seal the opening where sample liquid has been spotted onto the slide and repair any curling of the slide that may have resulted from pushing the slide into the incubator.

With respect to the guide member being an inclined member, both Arai et al and Sugaya teach the guide member as a flat member. However, Applicants have not shown the criticality in having the guide member being an incline structure. Absent evidence that the inclined structure serves a purpose or provides an advantage, the feature is considered to be a matter of design choice which does not sufficiently limit the claim to make it patentable.

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Response to Arguments

6. Applicant's arguments filed September 29, 2004 have been fully considered but they are not persuasive.

Regarding the anticipation rejection over Arai et al, Applicants argue that there is no teaching in Arai et al that the heater (57) heats the guide member to a predetermined temperature. In response, the Examiner would like to point to col. 11, lines 35-40, where Arai et al teach that the heater (57) holds the cell member (64) and pressing member (61) at a predetermined temperature. The guide (64b) is a part of the cell member. Thus, the heater (57) does heat the guide to a predetermined temperature. The Examiner notes that the heater may not be directly disposed on the guide; however, such is not required by the claims. The claims do not exclude indirect heating.

Applicants further argue that Arai et al fail to teach removing the pressing member from the cell. In response, Arai et al teach that the cell member (64) can be easily removed from the incubator for cleaning or replacement (col. 11, lines 59-61; col. 12, lines 14-16). The pressing member may be integral with the cell member, so it too can be removed from the incubator. Once the cell is removed, cell (42) no longer exists. Thus, the pressing member has been removed from the cell.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LaToya I. Cross whose telephone number is 571-272-1256. The examiner can normally be reached on Monday-Friday 8:30 a.m. - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill A. Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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